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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/416,267 10/12/99 SU

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HM22/0907

EXAMINER

MERTZ, P

ART UNIT

PAPER NUMBER

1646

10

DATE MAILED:

09/07/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/416,267

Applicant(s)

Su et al.

Examiner

Prema Mertz

Group Art Unit

1646



☒ Responsive to communication(s) filed on Jul 27, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 17-19 and 23-79 is/are pending in the application.

Of the above, claim(s) 17-19, 23, and 24 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 25-79 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### DETAILED ACTION

Claims 1-16 and 20-22 have been canceled in Paper No. 9, 7/27/00. New claims 25-79, drawn to the elected invention (Paper No. 9, 7/27/00), and original claims 17-19, 23-24, are pending and under consideration by the Examiner.

#### *Election/Restriction*

1. Applicant's election with traverse of Group II (originally filed canceled claims 14-16) now, new claims 25-79, in Paper No. 9, 7/27/00, is acknowledged. The traversal is on the ground(s) that the restriction is improper since the examiner has not shown that examination of Groups I-VII, would entail a serious burden. This is not found persuasive because the searches for the 7 Groups would not overlap, all the inventions being classified in different classes and subclasses. Applicants are directed to MPEP 808.02 which states that "Where the related inventions as claimed are shown to be distinct and under the criteria of MPEP 806.05 (c-I), the examiner in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: 1) Separate classification thereof." In the instant case, the different Groups are classified into different classes and subclasses based upon the disparate and distinct inventions.

The test for propriety of restriction is not whether the inventions are related but rather whether they are distinct and whether it would impose a burden on the examiner to search and examine multiple inventions in a single invention. Group I drawn to the polynucleotide and Groups II-VII are unrelated distinct inventions because a search of the literature for the polynucleotide of Group I, would not be expected to reveal art for a compound which activates the cytokine encoded

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by the polynucleotide of Group I or a compound which inhibits activation of the cytokine encoded by the polynucleotide of Group I or a method of treatment with the cytokine encoded by the polynucleotide of Group I, which searches are extensive requiring separate searches which would be unduly burdensome.

Having shown that these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter as defined by MPEP § 808.02, the Examiner has *prima facie* shown a serious burden of search (see MPEP § 803). Therefore, an initial requirement of restriction for examination purposes as indicated is proper.

The Groups as delineated in the restriction requirement (Paper No. 7, 6/27/00) are patentably distinct one from the other such that each invention could, by itself, in principle, support its own separate patent (as shown by the arguments put forth in the written restriction requirement).

The requirement is still deemed proper and is therefore made FINAL.

Claims 17-19 and 23-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed in Paper No. 9 (7/27/00).

***Claim rejections-35 USC § 101***

2. Claims 25-79 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.

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The instant application has provided a description of an isolated DNA encoding a protein and the protein encoded thereby. The instant application does not disclose the biological role of this protein or its significance.

It is clear from the instant specification that the polypeptide comprising the amino acid sequence set forth in SEQ ID NO:2 is termed an "orphan protein" in the art. This is a protein whose cDNA has been isolated because of its similarity to known proteins. There is little doubt that, after complete characterization, this protein will probably be found to have a patentable utility. This further characterization, however, is part of the act of invention and until it has been undertaken, Applicants claimed invention is incomplete. The instant situation is directly analogous to that which was addressed in *Brenner v. Manson*, 148 U.S.P.Q. 689 (Sus. Ct, 1966), in which a novel compound which was structurally analogous to other compounds which were known to possess anti-cancer activity was alleged to be potentially useful as an antitumor agent in the absence of evidence supporting this utility. The court expressed the opinion that all chemical compounds are "useful" to the chemical arts when this term is given its broadest interpretation. However, the Court held that this broad interpretation was not the intended definition of "useful" as it appears in 35 U.S.C. § 101, which requires that an invention must have either an immediate obvious or fully disclosed "real world" utility. The Court held that:

"The basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility", "[u]nless and until a process is refined and developed to this point-where specific benefit exists in currently available form-there is insufficient justification for permitting an applicant to engross what may prove to be a broad field", and "a patent is not a hunting license", "[i]t is not a reward for the search, but compensation for its successful conclusion."

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The instant claims are drawn to a protein of as yet undetermined function or biological significance. Until some actual and specific significance can be attributed to the protein identified in the specification as a novel human cytokine, or the cDNA encoding it, the instant invention is incomplete. In the absence of a knowledge of the biological significance of this protein, there is no immediately obvious "patentable" use for it. To employ a protein of the instant invention in the identification of substances which inhibit or augment its activity is clearly to use it as the object of further research which has been determined by the Courts to be a non-patentable utility. Since the instant specification does not disclose a "real world" use for the claimed polynucleotide or the protein encoded thereby, then the claimed invention is incomplete and, therefore, does not meet the requirements of 35 U.S.C. 101 as being useful. Furthermore, because the claimed invention is not supported by a specific asserted utility for the reasons set forth above, credibility cannot be ascertained.

Claims 25-79 are also rejected under 35 U.S.C. 112, first paragraph, as failing to adequately teach how to use the instant invention. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

***Claim rejections-35 USC § 112, first paragraph***

3. Claims 34-42 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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The deposit of the biological material is considered necessary for the enablement of the current invention (see M.P.E.P. Chapter 2400 and 37 C.F.R. §§ 1.801-1.809). Elements required for practicing a claimed invention must be known and readily available to the public or obtainable by a repeatable method set forth in the specification. While applicants have provided the deposit number for the plasmid comprising the cDNA clone ATCC Deposit No. 97486 (page 19), the specification is not fully compliant with all of the provisions for maintenance and availability of the deposited material. The deposited material has been accepted for deposit under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure (e.g., see 961 OG 21, 1977), and Applicants, their assignee or their agent needs to provide a declaration containing the following:

A statement that all restrictions on the availability to the public of the material so deposited will be irrevocably removed upon the granting of a patent.

A statement that the material has been deposited under conditions that assure that access to the material will be available during the pendency of the patent application to one determined by the Commissioner to be entitled thereto under 37 C.F.R. 1.14 and 35 U.S.C. § 122.

A statement that the deposited material will be maintained with all of the care necessary to keep it viable and uncontaminated for a period of at least five years after the most recent request for the furnishing of a sample of the deposited microorganism, and in any case, for a period of at least thirty years after the date of deposit or for the enforceable life of the patent, whichever period is longer.

A statement by declarant that all statements made therein of declarant's knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the instant patent application or any patent issuing thereon.

### ***Conclusion***

No claims are allowed.

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*Advisory Information*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (703) 308-4229. The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4227. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Prema Mertz*  
Prema Mertz Ph.D.  
Primary Examiner  
Art Unit 1646  
August 28, 2000